

REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims comply with 35 U.S.C. § 112, are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.

The applicants will now address each of the issues raised in the outstanding Office Action.

Rejections under 35 U.S.C. § 112

Claims 7-24, 26-30, 48-65, 67-76 rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The claims are rejected because the Examiner contends that claim 9:

recites a plurality of search results and each result is associated with domain identifier. The claim also recites that the step of a) thru d) are repeated. Therefore, there could be more than one domain identifiers associated with user selections. It is unclear which of the domain identifiers is inputted by the advertiser or accepted as an input

(Paper No. 20091221, page 2.) The other independent claims had a similar issue.

The applicants intended that **any one of** the domain identifiers (or document identifiers in some of the claims) could be input. The claims have been amended to replace "the domain identifier" or "the document identifier" input by the advertiser with "a domain identifier" or "a document identifier."

The Examiner also contends:

Claim 9 also recites repeating acts a) through d). Does it mean that the same search query (with the same term or phrase) is receiving again, and also the same search results for the same search query is generated? If that is the case the same selection and the same association with the same document identifier is stored, which implies that the aggregated data would only include the same selection and same association

(Paper No. 20091221, page 3.) The claimed method may process the same search query and selected search results, and/or different search queries and different selected search results, from the same user or from

different users. Since the public would be apprised of what constitutes infringement, the applicants believe that the portion of the independent claims cited by the Examiner did not render the claims indefinite. However, in order to expedite prosecution, the independent claims have been amended to clarify this aspect of the claimed invention. The applicants finally note that even if the same search query is entered, this does not necessarily mean that the same selection and the same domain (or document) identifier association is stored as alleged by the Examiner. For example, the same search result submitted at different times (or from different locations, or by different users) might yield different search results. Furthermore, even if the search results were the same for a given search query, different users might select different search results.

In any event, the applicants believe that the foregoing amendments should address the Examiner's concerns. ***If there are any outstanding concerns, the applicants request that the Examiner contact the undersigned in advance of any further action on the merits so that any such issues may be resolved expeditiously.***

Rejections under 35 U.S.C. § 102

Claims 9-14, 17-31, 50-55 and 58-72 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,421,675 ("the Ryan patent"). The applicants respectfully request that the Examiner reconsider and

withdraw this ground of rejection in view of the following.

Independent claims 9, 17, 50 and 58 are not anticipated by the Ryan patent because the Ryan patent does not teach a combination of: (1) accepting as an advertiser input of an advertiser, a domain identifier (or a document identifier); (2) obtaining, using the accepted domain identifier (or document identifier), at least one of (A) one or more terms and (B) one or more phrases from a stored set of aggregated domain identifier-to-search query (or aggregated document identifier-to-search query) information associations (generated as claimed); (3) providing the obtained at least one of the (A) one or more terms and (B) one or more phrases as ad targeting information stored in association with an ad of the advertiser, wherein the ad has a landing page document, and wherein the landing page document belongs to a domain identified by the domain identifier accepted as the advertiser input; and (4) controlling a serving of the ad using the at least one of the (A) one or more terms and (B) one or more phrases, stored in association with the ad as the ad targeting information.

Although the Ryan patent discusses generating a Keyword-URL link Table (See, e.g., column 12, lines 16-60.), such Keyword-URL link information is not used in the manner claimed. Rather, it may be used "to prioritize those web listings that have been selected the most with respect to a given keyword, and thereby presenting first the most popular web page listings in a subsequent search using the same keyword search entry." (Abstract of the Ryan patent) That is, such information

is not stored as targeting information of an ad (which is used to control the serving of the ad), and there is no relationship between a landing page of the ad, and the term(s) and/or phrase(s) stored as ad targeting information.

Although the Ryan patent discusses a "key word suggester," keyword suggestions are not generated from the Keyword-URL link Table (nor are they generated from the stored associations as claimed). (See, e.g., column 28, line 18 through column 29, line 57 of the Ryan patent.) Further, the keyword suggestions are not used to target the serving of an ad as claimed. Rather, the "key word suggester" in the Ryan patent is use to help users to find appropriate keywords when searching. (See, e.g., column 27, line 54 through column 28, line 17 of the Ryan patent.) That is, keywords provided from the "key word suggester" in the Ryan patent are not stored as targeting information of an ad (which is used to control the serving of the ad), and there is no relationship between a landing page of the ad, and the term(s) and/or phrase(s) stored as ad targeting information.

Finally, the applicants respectfully submit that the rejection of independent claim 9 (and claims 17, 50 and 58)

- (1) does not address element (h) (See Paper No. 20091221, page 4.),
- (2) does not specify what portion of Figures 15-23 allegedly teach element (i) (See Paper No. 20091221, page 4.), and
- (3) improperly ignores wherein clauses that specify a relationship between an ad, its landing page

document, and an identified domain (or an identified document) (See Paper No. 20091221, page 4.).

If this ground of rejection is to be maintained, the applicants respectfully submit that such a rejection should address element (h), specify what portion of Figures 15-23 allegedly teach element (i), and give proper patentable weight to the relationships defined by the wherein clauses of element (j). The applicants further submit that such a rejection must properly consider the fact that since element (k) uses the stored ad targeting information to control the serving of the ad, such information is not merely related to the ad for an "intended use."

Thus, the applicants respectfully submit that independent claims 9, 17, 50 and 58 are not anticipated by the Ryan patent for at least the foregoing reasons. Since each of the remaining claims under this rejection directly or indirectly depends from one of these claims, they are similarly not anticipated by the Ryan patent.

Rejections under 35 U.S.C. § 103

Claims 10, 11 and 73-76 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Ryan patent further in view of U.S. Patent Application Publication No. 2005/0097204 ("the Horowitz publication"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

First, since claims 10 and 11 were rejected above, and since claims 7, 8, 15, 16, 48, 49, 56 and 57 are

addressed under this rejection, the applicants assume that the Examiner intended to reject claims 7, 8, 15, 16, 48, 49, 56, 57 and 73-76.

Independent claims 73-76 are not rendered obvious by the Ryan patent and the Horowitz publication at least because these references neither teach, nor make obvious, a combination of: (1) accepting, as an advertiser input of an advertiser, a domain identifier (or a document identifier); (2) obtaining, using the accepted domain identifier (or document identifier), at least one of (A) one or more terms and (B) one or more phrases from a stored set of aggregated domain identifier-to-search query (or document identifier-to-search query) information associations (generated as claimed); (3) providing the obtained at least one of the (A) one or more terms and (B) one or more phrases as ad information stored in association with an ad of the advertiser, wherein the ad has a landing page document, and wherein the landing page document belongs to a domain identified by the domain identifier (or that is identified by the document identifier) accepted as the advertiser input; (4) generating creative information of the ad using the at least one of the (A) one or more terms and (B) one or more phrases as content of the ad; and (5) serving the generated creative information of the ad to induce rendering of the creative information of the ad on a client device.

The Examiner alleges that the Ryan patent teaches all of the foregoing features except generating creative information. The applicants respectfully disagree for reasons similar to those discussed above.

To address the conceded deficiency of the Ryan patent, the Examiner relies on the Horowitz publication as teaching generating advertisements, citing paragraphs [0009] and [0089]. (See Paper No. 20091221, page 10.) First, the Horowitz publication itself might only be prior art if the provisional application to which it claims priority supports the subject matter relied on to make the rejection. This is because the September 23, 2004 filing date of the Horowitz publication is later than the March 31, 2004 filing date of the present application. In this regard, MPEP 2136.03 (III) states, in pertinent part:

The 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application with certain exceptions ***if the provisional application(s) properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph.*** [Emphasis added.]

The applicants undertook a cursory review of U.S. Provisional Application Serial No. 60/504,963 ("the '963 provisional"), to which the Horowitz publication claims priority, but were unable to find support for the subject matter relied upon to make the rejection.

If this ground of rejection is maintained, the applicants respectfully submit that such a rejection

should refer to the portions of the '963 provisional relied upon to make the rejection.

Thus, the applicants respectfully submit that independent claims 73-76 are not anticipated by the Ryan patent for at least the foregoing reasons. Since each of claims 7, 8, 15, 16, 48, 49, 56 and 57 directly or indirectly depend from one of these independent claims, they are similarly not rendered obvious by the Ryan patent and the Horowitz publication.

Conclusion

In view of the foregoing amendments and remarks, the applicants respectfully submit that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

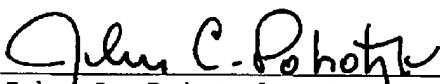
Any arguments made in this amendment pertain **only** to the specific aspects of the invention **claimed**. Any claim amendments or cancellations, and any arguments, are made **without prejudice to, or disclaimer of**, the applicants' right to seek patent protection of any unclaimed (e.g., narrower, broader, different) subject matter, such as by way of a continuation or divisional patent application for example.

Since the applicants' remarks, amendments, and/or filings with respect to the Examiner's objections and/or rejections are sufficient to overcome these objections and/or rejections, the applicants' silence as to assertions by the Examiner in the Office Action and/or to certain facts or conclusions that may be implied by

objections and/or rejections in the Office Action (such as, for example, whether a reference constitutes prior art, whether references have been properly combined or modified, whether dependent claims are separately patentable, etc.) is not a concession by the applicants that such assertions and/or implications are accurate, and that all requirements for an objection and/or a rejection have been met. Thus, the applicants reserve the right to analyze and dispute any such assertions and implications in the future.

Respectfully submitted,

June 1, 2010

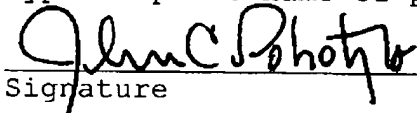

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